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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,884	09/09/2003	Ronald Scott Carruth	587-01	2620

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EXAMINER

KHAIRA, NAVNEET K

ART UNIT PAPER NUMBER

3754

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/657,884

Applicant(s)

CARRUTH ET AL.

Examiner

Navneet K. Khaira

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-31 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 22-24, 26-28, 30 and 31 is/are allowed.  
6) ☐ Claim(s) 19-21, 25 and 29 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 24 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, 'the attachment comprising a body having a guide located in a vicinity of only one of said lateral edges wherein another of said lateral edges is free of any guide' must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 19-21, 25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lavoie et al (US 5,749,498).

Referring to claims 19 and 25, Lavoie discloses a caulking gun having a container (12) filled with an extrudable material to be dispensed (col 2, line 8), means for forcing (plunger 14) the material out of the container (12), a shank (40) defining a passage for extrudable material connected to a tip (10, fig 1), the outlet portion, the tip (10) being configured to receive that material being ejected from the container (12) and to distribute the material through a plurality of spaced-apart openings (col 2, lines 53-56) formed in an outlet portion of the tip (10), the outlet portion having upper and lower surfaces (fig 1, plane on which openings lie) which are spaced apart to define a thickness of the outlet portion (48,50), the outlet portion having a pair of lateral edges(46) defining a width of the outlet portion (plane on which openings lie), the width being greater than said thickness (fig 1), the improvement wherein the tip (10) includes a guide (46), it would have been obvious to anyone skilled in the art to add only one

Art Unit: 3754

guide (46) instead of two located at only one of said lateral edges (46, end of plane on which openings lie) depending on the task being performed by the by the tool, wherein at least a portion of the guide extends outside a place of one of said surfaces (46 extends away from the plane on which openings lie, and wherein another of said lateral edges is free of any guide, it would have been obvious to eliminate one of the guides if the applicator is used for applying material to a surface having a width greater than the width of the applicator. It would have also been obvious to eliminate a second guide if universal orientation function of the device is not desired. Because "omission of the element and its function is obvious if the function of the element is not desired", see MPEP 214404 IIB.

Referring to claim 20, Lavoie et al further discloses the guide (46) which is a planar wall, wherein the planar wall (46) defines a surface (fig 1) which is perpendicular to the surface on which the outlets (48,50) lie.

Referring to claim 21, Lavoie et al further discloses the guide (46, fig 1) has a thickness, and a width of the outlet portion (plane on which 48, 50 lie) of the tip (10) which appears to be least ten times greater than the thickness of the guide (46, Fig 1).

Referring to claim 29, Lavoie et al discloses a method of applying an extrudable material (col 1, line 67, fig 2) to an elongated structure, comprising:

Art Unit: 3754

a) providing a tip (10) having an outlet portion (48,50) defining a pair of spaced apart planar surfaces defining a thickness and two lateral edges (46, fig 1), wherein the lateral edges (46) are spaced apart (opposite ends of tip) by an amount greater than said thickness (length of 46), the tip having a guide (46) connected to the tip (10) at one of said lateral edges (46), it would have been obvious to eliminate one of the guides if the applicator is used for applying material to a surface having a width greater than the width of the applicator, at least a portion of the guide (46) extending outside a place of one of said planar surfaces (surface on which openings 48, 50 lie),

b) connecting the tip to a caulking gun by connecting means of pins (col 3, line 49),

c) engaging the guide(46, fig 2) with an edge of an elongated structure, and

d) extruding a material from the caulking gun while moving the tip along the elongated structure, while holding the guide in engagement with the edge of the elongated structure (col 2, lines 53-60).

#### **Allowable Subject Matter**

4. Claims 22-24, 26-28, and 30-31 are allowed.

#### **Remarks**

5. Applicant's remarks with respect to claims 19-21, 25, and 29 have been considered. Chao et al has a guide 5 along each lateral edge. The removal of one of the guides would have been considered the elimination of a step or an element and it's function. It has been established that the "Omission of an Element and Its Function Is

Art Unit: 3754

Obvious If the Function of the Element Is Not Desired". Ex parte Wu 10USPQ 2031 (Bd. Pat. App. & Inter. 1989). In this instance, the elimination of one of the guides would not have destroyed the function of the device because the applicator is used for applying material to a surface located between the lateral edges of the applicator (see Fig. 3). Also, see MPEP 2144.04 (II).

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3754

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Navneet K. Khaira whose telephone number is 703-305-0860. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mar Y. Michael can be reached on 703-308-2087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Navneet Sonia Khaira  
Examiner  
Art Unit 3754

04/18/05



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